

REMARKS

Applicant has carefully reviewed the Application in light of the Advisory Action mailed February 13, 2004. At the time of the Advisory Action, Claims 1-15 and 17-85 were pending in the Application. Applicant amends Claims 1, 3, 5-9, 11-14, 17-19, 21, 37-40, 45-46, 48-49, 51-55, 57-60, 63-65 and 84-85. Applicant cancels Claims 4, 10, 50, and 56 without prejudice or disclaimer. The amendments to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. Many of Applicant's amendments were only made to correct dependency or antecedent basis issues resulting from the cancellation of certain claims. All of Applicant's amendments are without prejudice or disclaimer and have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Section 102 Rejection

The Examiner previously rejected Claims 1, 3, 11, 17, 19, 36, 38-41, 47-49, 57, 63, 65, 82, and 84-85 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,434,616 issued to Urano et al. (hereinafter "*Urano*"). Applicant made a series of amendments to various Independent Claims that made this rejection moot. Applicant has overcome this rejection and has received formal notification to this effect in the Advisory Action.

Section 103 Rejections

Applicant also presents the following additional discussion in order to prevent the Examiner from any attempt to utilize a reference (*Urano*), which was clearly distinguished previously. The Examiner previously rejected Claim 2, 16, and 62 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,243,748 issued to Arai ("*Arai*"). The Examiner rejected Claims 4, 6, 10, 16, 50, 52, 56, and 62 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 5,961,595 issued to Kawagoe ("*Kawagoe*"). The Examiner rejected Claims 12, 34-35, 37, 58, 80-81, and 83 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,407,997 issued to DeNap ("*DeNap*"). The Examiner rejected Claims 13 and 59 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,363,072 issued to Furuichi

(“*Furuichi*”). The Examiner rejected Claims 14 and 60 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,065,061 issued to Blahut et al. (“*Blahut*”). The Examiner rejected Claims 15, 43, and 61-62 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Publication No. 2002/0126622 A1 issued to Kimball et al. (hereinafter “*Kimball*”). The Examiner rejected Claims 18 and 64 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,070,187 issued to Subramaniam et al. (“*Subramaniam*”). The Examiner rejected Claims 20 and 66 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Arai*. The Examiner rejected Claims 21-33, 42, 44-46, and 67-79 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of U.S. Patent No. 6,172,980 issued to Flanders et al. (“*Flanders*”). The Examiner rejected Claims 5 and 51 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Kawagoe* and in further view of *Arai*. The Examiner rejected Claims 7 and 53 as being rejected under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Kawagoe* and in further view of *DeNap*. The Examiner rejected Claims 8 and 54 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Kawagoe* and in further view of *Furuichi*. The Examiner rejected Claims 9 and 55 under 35 U.S.C. 103(a) as being unpatentable over *Urano* in view of *Kawagoe* and in further view of *Blahut*. These rejections are respectfully traversed for the following reasons.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.<sup>1</sup> It is respectfully submitted that Claim 1 is patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation.

For example, Independent Claim 1, as amended, recites receiving packet handling instructions from the service manager at the forwarding agent that include the actions determined by the service manager for the packet; receiving a subsequent packet at the forwarding agent; determining that the subsequent packet matches a criteria included in the

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<sup>1</sup> See M.P.E.P. § 2142-43.

packet handling instructions; and handling the subsequent packet at the forwarding agent according to the packet handling instructions. The Examiner concedes that these elements are absent from *Urano*. (See Office Action: p. 7-8.) However, the Examiner mistakenly contends that *Kawagoe* fills this void.

In contrast to the teachings of Independent Claim 1, *Kawagoe* discloses a network management system with a hardware resource management module shared between networks. At the passage relied on by the Examiner, *Kawagoe* discloses: "Fi[r]st of all, the manager 101 issues an operation request to a managed instance stored in the MIB 111 of the agent 102 according to the standard protocol. Upon receipt of the operation request, the agent 102 judges whether or not there exists the substance of an attribute to be processed by the operation request. If exists, it further judges whether it is necessary to modify the managed instance only stored in the MIB 111 of the agent 102 or read out the value thereof, or whether it is further necessary to modify or read out the data stored in the data base 112 managed by the resource manger 103." (See *Kawagoe* at Column 6, lines 25-35.) This passage clearly does not anticipate the identified limitation of Independent Claim 1.

As a preliminary issue, the passage above is describing the operation of FIGURE 4. This figure purportedly illustrates a procedure for converting a protocol, whereby messages are analyzed and converted and then a resource manager is invoked. (See FIGURE 4 of *Kawagoe*.) This is not akin to receiving packet handling instructions from the service manager at the forwarding agent that include the actions determined by the service manager for the packet, as recited in Independent Claim 1. The conversion of a protocol (the context of *Kawagoe*) is not related to the receiving of packet handling instructions from the service manager at the forwarding agent that include the actions determined by the service manager for the packet: nor does it relate to the architecture of subject matter of the pending claims. For at least this reason, Independent Claim 1 is patentable over *Kawagoe*. Notice to this effect is respectfully requested.

Moreover, *Urano* has a host of similar shortcomings. In addition to the flaws identified by the Examiner, *Urano* also suffers from a number of additional deficiencies. For example, *Urano* discloses a method, the patent being entitled: A Method For Monitoring Abnormal Behavior in a Computer System. The method includes collecting log information in order to detect an event. (See *Urano*, Column 2, lines 61-67.) Throughout *Urano*, the audience is informed of the importance of logging information. For example, at

one passage in the Background Section of *Urano*, the following is disclosed: "...methods for transferring various types of computer logs over a network for monitoring on another computer have been widely used. However, most of those methods transfer all logs, increasing the network load and sometimes developing a problem especially when the amount of log data produced by the sending computers exceeds the network transfer capacity." (See Column 1, lines 13-19.) Remaining with the Background Section, *Urano* continues: "...administrators must associate log messages sent from one computer with those sent from another computer or obtain more detailed information on the logs depending upon the output log...Conventionally, log information has been written directly to non-volatile storage. Log information is also written via a network to non-volatile which is usually remote non-volatile storage." (See Column 1, lines 37-52.) The Background Section ostensibly sets up the Summary Section, which provides "It is an object of the present invention to provide a method of collecting an amount of log information enough to keep track of the status of agents without heavy processing load on both the network and the manager computer...It is still another object of the present invention to provide a method of automating the association of log information output by a plurality of computer and, depending upon the output information, the collection of more detailed information in order to reduce the load on an administrator...To achieve the above objects, the method according to the present invention concurrently monitors log information collected from a plurality of computers and integrally checks the validity and consistency of the log information to find an invalid action." (See Column 1, lines 60-22.)

How any of this disclosure from *Urano*, in any way, anticipates the teachings of any of the pending claims is unclear. Applicant tested the bounds of his imagination in order to try and objectively evaluate *Urano* as somehow being relevant to the pending subject matter. Applicant is at a loss as to how anything having to do with keeping track of log information or ensuring the validity of log information relates to the forwarding agent and service manager disclosed by the above-identified claims. Moreover, Applicant consulted a dictionary to ascertain any other potential meanings associated with "log." According to the most relevant definition for this case, "log" is defined as: a record, as of the performance of a machine. *The American Heritage College Dictionary* 787 (3<sup>rd</sup> Ed. 1997). Again, Applicant reminds the Examiner that such a definition truly reveals how remote *Urano* is to the patentability of the pending claims.

Turning to the architecture of *Urano* in more detail, when one of the manager computer 104, console computer 106, and operator 105 detects an abnormal condition, the manager computer 104 collects more detailed [log] information. (See *Urano*, Column 5, lines 37-40.) In the example offered by *Urano*, the manager computer 104 supposes that an event has occurred and collects the logs to verify it. The method purportedly reduces the load on the manager computer 104 necessary to make an analysis and minimizes network traffic. (See *Urano*, Column 6, lines 5-13.) However, nowhere in *Urano* is there any disclosure, teaching, or suggestion of receiving instructions and processing packets according to the instructions as recited in the above-identified claims. Applicant pointed out as much in the previous response, which was a result of the Examiner's Office Action of October 3, 2002. While it is true that an instruction is provided in the system of *Urano*, that instruction is incapable of indicating how packets are to be processed. Moreover, the "instruction" disclosed by *Urano* reflects rules governing which log is important and which log should be sent to the manager computer. (See *Urano* generally at Column 4, lines 28-52.) This is not akin to receiving instructions and processing packets according to the instructions as recited in the above-identified claims. For at least this reason, these claims are patentable over *Urano*. Additionally, Claims 11, 17, 19, and 36 depend from Independent Claim 3 and are therefore also allowable over *Urano*. Also, Claims 39, 40, 41, and 47 and Claims 57, 63, 65, and 82 depend from Independent Claims 38 and 49 respectively and are therefore also allowable over *Urano* for similar reasons. Accordingly, *Urano* does not anticipate Claims 1, 3, 11, 17, 19, 36, 38-41, 47-49, 57, 63, 65, 82, and 84-85. Notice to this effect is respectfully requested in the form of an allowance of these claims.

Applicants also wish to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, the proposed *Urano-Kawagoe* combination is still improper because these references do not appear to be analogous art. In examining a patent application, an Examiner must first determine what is analogous prior art for the purpose of analyzing the obviousness of the subject matter at issue.<sup>2</sup> In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular

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<sup>2</sup> M.P.E.P. § 2141.01(a).

problem with which the inventor was concerned.<sup>3</sup> A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which because of the matter with which it deals, logically would have commended itself to an inventor's attention when considering his problem.<sup>4</sup> *Kawagoe* is not directed to the field of packet handling instructions and, therefore, is not in Applicant's field of endeavor.

Even assuming for the sake of argument that *Urano* and *Kawagoe* are analogous art, the rejection of Claims 1 would still be improper because the Examiner has not shown the required suggestion or motivation in *Urano* or *Kawagoe*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.<sup>5</sup> Thus, the mere fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.<sup>6</sup> Nothing in *Urano* or *Kawagoe* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.<sup>7</sup> Speculation in hindsight that "it would have been obvious" to make the proposed combination because the proposed combination would be helpful is insufficient

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<sup>3</sup> *In re Oetiker*, 977 F.2d 1443, 1446 (Fed. Cir. 1992).

<sup>4</sup> *In re Clay*, 966 F.2d 656, 659 (Fed. Cir. 1992).

<sup>5</sup> M.P.E.P. § 2143.01 (emphasis in original).

<sup>6</sup> *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

<sup>7</sup> If "common knowledge" or "well known" art is being relied on to combine the references, Applicants respectfully request that a reference be provided in support of this position pursuant to M.P.E.P. § 2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicants respectfully request that an affidavit supporting such facts be provided pursuant to M.P.E.P. § 2144.03.

under the M.P.E.P.<sup>8</sup> and governing Federal Circuit case law.<sup>9</sup> The M.P.E.P. also confirms that this approach is improper and, thus, it should not be used here.<sup>10</sup>

Thus, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.<sup>11</sup> The factual inquiry whether to combine references must be thorough and searching.<sup>12</sup> This factual question cannot be resolved on subjective belief and unknown authority;<sup>13</sup> it must be based on objective evidence of record.<sup>14</sup>

Furthermore, the Examiner is precluded from modifying the combined teachings of *Urano* and *Kawagoe* in an effort to teach the limitations of the pending claims because there is no indication in any of the references as to the desirability of making such modifications. The cited references must disclose the desirability of making the proposed modification.<sup>15</sup> The fact that the modification is possible or even advantageous is not enough.<sup>16</sup> A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.<sup>17</sup>

With respect to the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. The

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<sup>8</sup> See M.P.E.P. § 2145 X.C. ("The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.").

<sup>9</sup> For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant's invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 ("Conspicuously missing from this record is any evidence, other than the PTO's speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].").

<sup>10</sup> See M.P.E.P. §2145.

<sup>11</sup> See *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986).

<sup>12</sup> See *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ 2d 1001, 1008 (Fed. Cir. 2001).

<sup>13</sup> See *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ 2d 1430, 1434 (Fed. Cir. 2002).

<sup>14</sup> *Id.* at 1343, 61 USPQ 2d at 1434.

<sup>15</sup> *In re Mills*, 916 F.2d 680, 682 (Fed. Cir. 1990).

<sup>16</sup> See *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984).

<sup>17</sup> *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). (See also M.P.E.P. §2141.02).

combinations of *Urano* and *Kawagoe* would not be capable of performing the operations required by the claimed invention. For example, there is no showing by the Examiner that the teachings of *Urano* could provide the receiving of packet handling instructions from the service manager at the forwarding agent that include the actions determined by the service manager for the packet function identified above; nor is there any disclosure relating to the other elements identified in the pending claims in the analysis provided supra. The proposed combination (presumptively) attempts to combine divergent subject matter that has not been shown to be capable of operating according to any degree of predictability. The Examiner, without resorting to improper hindsight to look through the claimed invention, has not addressed the chance that the proposed *Urano-Kawagoe* combination would have any success whatsoever: let alone a reasonable expectation of success as is required. Therefore, Applicant respectfully submits that the Examiner has failed to establish the second criteria for a prima facie case of obviousness.

If we again assume for the sake of argument that *Urano* and *Kawagoe* are analogous art, and that there is the required suggestion or motivation to combine *Vaez-Iravani* with *Judge*, the proposed *Urano-Kawagoe* combination would fail because the limitations specifically recited in the pending claims are not disclosed in each of the references, as discussed above. Accordingly, such an argument is flawed in that it does not satisfy the third criterion of obviousness, as identified in the analysis above.

Independent Claims 3, 38, 48, 49, 84, and 85 recite limitations similar, but not identical, to those recited in independent Claim 1 with respect to disclosing a portable handheld apparatus. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these independent claims are also patentably distinct for analogous reasons. Notice to this effect is respectfully requested in the form of a full allowance of all the pending claims.




CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of \$770.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney at the number provided below.

Respectfully submitted,  
BAKER BOTTS L.L.P.  
Attorneys for Applicant

  
Thomas Frame  
Reg. No. 47,232

Date: April 16<sup>th</sup>, 2004

CORRESPONDENCE ADDRESS:

2001 Ross Avenue, Suite 600  
Dallas, TX 75201-2980  
(214) 953-6675  
(214) 661-4675 - Fax

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